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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/841,847 05/05/97 SCHUTT

E ALLIA.62FIC3

EXAMINER

HM22/1220

NED A ISRAELSEN
KNOBBE MARTENS OLSON AND BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

HOLLINDEN, G

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

12/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/841,847

Applicant(s)

Schutt

Examiner
Gary E. Hollinden

Group Art Unit
1616



☒ Responsive to communication(s) filed on 11/5/99, 12/8/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 62, 66-76, 79-91, 94-126, 128, and 131-154 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 62, 66-76, 79-91, 94-126, 128, and 131-154 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The request filed on December 8, 1999 for a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) based on parent Application serial No. 08/841,847 is acceptable and a CPA (with the same serial number) has been established. An action on the merits follows:

Claims 62, 66-76, 79-91, 94-126, 128, 131-134 have been presented for examination and will be reviewed on their merits. The preliminary amendment, filed December 8, 1999,¹ wherein claims 62, 109, and 123 were amended, was entered prior to this examination on the merits.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 62, 66-76, 79-91, 94-126, 128, 131-134 are rejected under 35 U.S.C. § 103 as being unpatentable over Lambert et al. (5,552,133), Quay (5,573,751), and Schneider et al. (5,413,774) for reasons of record stated in the Office Action dated September 16, 1998.

Applicant's arguments filed on December 8, 1999 have been fully considered but they are not deemed to be persuasive. In particular, Applicant asserts that the (newly added) requirement that the gas osmotic agent and the modifier gas are in a fixed molar ratio effective to stabilize the microbubbles renders the claims unobvious because the prior art does not teach that their combination is intended

¹The same amendment was first submitted on November 5, 1999 but was not entered by the Examiner (as set forth in the Advisory action dated November 16, 1999).

to stabilize the microbubbles. However, in *ex parte* prosecution, the language of the claims is given the broadest reasonable meaning of words in their ordinary usage as they would be understood by one of ordinary skill in art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by written description in Applicant's specification.² In the case of the phrase set forth above, the broadest reasonable meaning would be that the two gases could be in any molar ratio which affords some stability to the microbubble. Since improving the stability of the microbubbles has been the primary goal of essentially all work in this field, one would certainly expect that the prior art compositions would have been selected for increasing the stability of the microbubble compositions used.³ In addition, the phrase "effective to stabilize" is not particularly meaningful since it does not express what the reference standard is; i.e. stable as compared to what? Certainly, all of the prior art preparations are at least somewhat stable for some period of time. Without a particular quantitative requirement as to how long and under what conditions the microbubbles must survive to constitute an effectively stabilized preparation, said phrase does not effectively limit the claims.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. § 103. Therefore, the rejection is adhered to.

Claims 62, 66-76, 79-91, 94-126, 128, 131-134 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. patent no. 5,733,527, 5,626,833, 5,605,673, 5,695,741, and 5,720,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because each are drawn to compositions comprising at least two gases and/or methods of using them for ultrasound.

Claims 62, 66-76, 79-91, 94-126, 128, 131-134 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

²*In re Morris*, 44 USPQ 2d 1023, CA FC 1997; see also *In re Zletz*, 13 USPQ 2d 1320, CA FC 1989.

³one cannot imagine that the prior art artisans selected gas ratios that would destabilize their microbubble preparations!

unpatentable over the claims of copending application serial nos. 08/841,846, 08/986,879, 09/013,357, and 09/092,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because each are drawn to compositions comprising at least two gases and/or methods of using them for ultrasound.

The obviousness-type double patenting rejection, whether of the obviousness type or non-obviousness type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent⁴.

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

In view of the objections /rejections to the pending claims set forth above, no claims may be allowed at this time.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at 703/308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15 1989.

Any inquiry concerning this Office Action or any earlier Office Actions in this application should be directed to Dr. Gary E. Hollinden whose telephone number is 703/308-4521. Dr. Hollinden's office hours are from 6:30 am to 3:00 pm on Monday through Friday.

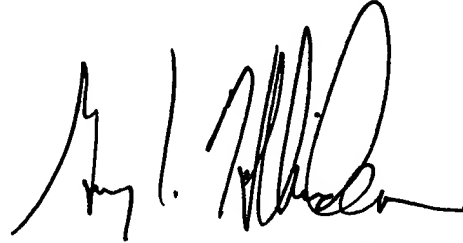
⁴*In re Thorington*, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 214 USPQ 761 (CCPA 1982); *In re Longi*, 225 USPQ 645 (CA FC 1985); and *In re Goodman*, 29 USPQ 2010 (CA FC 1993).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-1235.

A handwritten signature in black ink, appearing to read 'Gary E. Hollinden', with a large, stylized loop at the end.

Gary E. Hollinden, Ph.D.
Primary Examiner
Group 1600